
Remarks:

R9 Claims 1 to 10, 12, and 13 are pending in the application.

R10 Claims 1 to 10, 12, and 13 stand rejected.

R11 Applicant notes entry of the amendment filed 12/06/2007.

R12 A Response to Arguments concerning Applicant's previous arguments with respect to the previous objection to claim 10 under 35 U.S.C. §112 first paragraph has not been provided in the outstanding Office Action. Applicant attempted to obtain clarification regarding the incomplete objection at point 6 of the outstanding Office Action from the Examiner over the telephone on January 29, 2009. The Examiner stated that he was not interested in reviewing the Office Action itself. Applicant proceeds, under the belief that Applicant's previous arguments have been persuasive and satisfactorily addressed the Examiner's previous objection, the paragraph at point 6 being a remnant from a previous office action.

R13 Applicant respectfully submits that point 9 of the outstanding Office Action does not amount to an outstanding objection. Applicant attempted to obtain clarification regarding the incomplete paragraph at point 9 of the outstanding Office Action from the Examiner over the telephone on January 29, 2009. The Examiner stated that he was not interested in reviewing the Office Action itself. Applicant proceeds, under the belief that point 9 does not represent an outstanding issue to be addressed.

R14 Applicant notes that the Examiner's previous objection to "a new matter" is now closed in accordance with Examiner's statement at the bottom of page 6 of the outstanding Office Action.

R14 Applicant notes that the Examiner's previous objection to amendments requiring further consideration is now closed in view of Examiner's comments in the middle of page 7 of the outstanding Office Action.

R15 Claims 1, 10 and 12 have been amended to clarify the claim element "carrier" to read --carrier telecommunications company associated with the wireless mobile station--. The amendment has been proposed previously. Support for the amendment is found in second paragraph on page 9 of the originally filed application.

R16 It is submitted that no additional subject matter has been introduced by the amendment.

Arguments:

A7 Claims 1 to 10, 12, and 13 stand rejected under the non-statutory double patenting standard in view of co-pending commonly assigned U.S. Patent 7,222,340. Applicant respectfully submits that the rejection is unwarranted. The following address both the Examiner's Response to previous Argument A3 on page 8 of the outstanding Office Action and the outstanding objection at points 4 and 5 of the outstanding Office Action.

- a) The Examiner's articulated reasoning states "The subject matter claimed in the instant application is fully disclosed in the [U.S. 7,222,340] patent and is covered by the patent ..."

Applicant respectfully submits that the citability standard with respect to a non-statutory double patenting objection is stated in MPEP in §804.II.B.1 which reads:

A double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. §103" except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967).

Therefore, Applicant respectfully submits that what U.S. Patent 7,222,340 discloses is irrelevant and a finding of non-statutory double patenting based solely on subject matter disclosed in the prior patent is insufficient to substantiate a finding of non-statutory double patenting.

- b) Applicant respectfully provides the following excerpt from MPEP in §804.II.B.1 wherein:

... the analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. §103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

...

The conclusion of obviousness-type double patenting is made in light of [] factual determinations.

Any obviousness-type double patenting rejection should make clear:

- (A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue [] would have been an obvious variation of the invention defined in a claim in the patent.

Applicant notes that the Examiner's outstanding rejection fails to mention which U.S. Patent 7,222,340 claims the Examiner finds the claims of the preset application objectionable over. The Examiner further states that an articulated rejection is found in the previous Office Action dated July 2, 2007.

In the second sentence last of paragraph on page 3 of the July 2, 2007 Office Action, Examiner concludes that "... claims 1-15 of U.S. Patent 7,222,340 contains every element of claims 1-[10, 12 and 13] of the instant application, and thus anticipate the claims of the instant application." However, this conclusion is contradicted by the Examiner's own findings at line 3 of the last paragraph on page 3 of the July 2, 2007 Office Action wherein the Examiner states "... the conflicting claims are not identical ... For example, ... application 10/765,111 claims updating through a network." Therefore, Applicant respectfully submits that the conditions for same-invention double patenting are not met.

In *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 23 USPQ2d, 1893, 1845 (Fed. Cir. 1992) the Federal Circuit stated:

it is important to bear in mind that comparison can be made only with what invention is claimed in the earlier patent, paying careful attention to the rules of claim interpretation to determine

what invention a claim defines and not looking to the claim for anything that happens to be mentioned in it as though it were a prior art reference.

As acknowledged by the Examiner, the claims of the present application define methods of dynamically managing non-volatile memory items on a wireless device through a network. In contrast, the claims of U.S. Patent 7,222,340 define methods for dynamically managing non-volatile memory items on a wireless device from non-volatile memory item values stored in a software load on said wireless device. The claims of the present application further define network transaction update/rollback steps not present in the claims of U.S. Patent 7,222,340.

The rest of the Examiner's articulated objection reads "... it would be obvious that the wireless device in US Patent 7,222,340 would receive and transmit data to update through a network also." The requisite analysis from the point of view of a person of ordinary skill in the art to support such a conclusion has not been provided.

In *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985) and in *In re Kaplan*, 789 f.2d 1574, 229 USPQ678, 281 (Fed. Cir. 1986) the Federal Circuit stated that unsubstantiated conclusory assertions with respect to obviousness-type double patenting are legally inadequate.

Applicant respectfully traverses the Examiner's conclusory statement at lines 2 to 4 on page 4 of the July 2, 2007 Office Action as insufficient to establish a *prima facie* case of obviousness for failure to produce the requisite analysis under the non-statutory double patenting standard.

- c) In paragraph 4 page 3 of the outstanding Office Action, the Examiner challenges that "there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured to patent"

Applicant respectfully submits that sufficient reasons exist:

- 37 C.F.R. §1.141(a) reads: "Two or more independent and distinct inventions may not be claimed in one national application". In *Barrett v. Hall*, 2 F. Cas. 914, 925 (C.C.D. Mass. 1818) (No. 1,047) the court held that "two separate inventions cannot be patented in one patent."
- U.S. Patent 7,222,340 and the present application are classified in different classes.

Applicant respectfully submits that every facet of non-statutory double patenting has been addressed.

A8 Claims 1, 3 to 10 and 12 stand rejected under 35 U.S.C. §102(e) as anticipated by Birum.

Independent claims 1, 10 and 12, as amended, relate to the sending of a software identifier along with an identifier indicating a carrier telecommunications company associated with the wireless device, and to a mobile station sending same. Birum does not describe sending an identifier indicating a carrier telecommunications company associated with the wireless device.

Therefore, Applicant respectfully submits that independent claims 1, 3 to 10 and 12 are novel over the cited prior art.

A9 Claims 2 and 13 stand rejected under 35 U.S.C. §103 over Birum in view of Moore.

Dependent claims 2 and 13 depend directly respectively from independent claims 1 and 12 and

therefore incorporate all respective limitations of independent claims 1 and 12. The articulated rejection relies on the teachings of Birum. Moore does not cure the deficiency with respect to sending an identifier indicating a carrier telecommunications company associated with the wireless device. Applicant respectfully submits that a *prima facie* case of obviousness in respect of dependent claims 2 and 13 has not been established.

A10 In *In re Oetiker*, 977, F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992), the Federal Circuit stated that “[i]f the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.”

Applicant respectfully submits that the above arguments raise questions regarding the establishment of a *prima facie* case of unpatentability.

Reconsideration and allowance are respectfully requested.

Respectfully submitted,



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